



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/405,088 09/27/99 USKELA

S 017.37498X00

020457 QM12/1211  
ANTONELLI TERRY STOUT AND KRAUS  
SUITE 1800  
1300 NORTH SEVENTEENTH STREET  
ARLINGTON VA 22209

EXAMINER

NGUYEN, B

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

12/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/405,088

Applicant(s)

USKELA ET AL.

Examiner

Binh-An D Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 September 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The disclosure is objected to because of the following informalities:

On page 4, line 21, the word "AN" should be changed to "An."

Appropriate correction is required.

2. Claims 1-11 are objected to because of the following informalities:

In claim 1, the recited terms "said communication network" (lines 4 and 8) must be changed to "said communications network" for consistency with their antecedence.

In claims 1, 4, and 7, all commas (,) which separate each limitation of the claims must be replaced with semicolons (;). Appropriate correction is required.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 11, the recited term "game server gateway," lines 6 and 1-2, respectively, renders the claims vague and indefinite. This term has not been clearly disclosed in the specification.

In claim 1, the recited phrase "said game server gateway" (line 6) lacks antecedent basis.

In claim 4, the recited phrase "said game sponsoring game" (line 6) lacks antecedent basis.

In claim 5, the recited phrase "said information" (lines 2-3) lacks antecedent basis.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 3, 4, 7, and 10, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by James et al. (5,964,660).

James et al. teach a system and method for sponsoring games network comprising a communications network (14); a game sponsor gateway in communication with communications network (5:12-17); a user terminal (12) in communication with the communications network to access game sponsoring gateway; a game server in communication with game sponsor gateway to supply games over communications network to user terminal; a sponsor content server in communication with game sponsoring gateway to supply advertising over the communications network to user terminal; a user data server 10 (7:1-10); means for supplying games to game sponsor gateway for delivery over the communications network to user terminal; means for selecting user specific advertising and inserting advertising into the game supplied to

Art Unit: 3713

user terminal (10:17-20); accessing game sponsoring gateway through a communications network; accessing a game from a game provider through game sponsoring gateway; selecting advertising for a specific user; and supplying advertising to the user; and user selecting advertising for display in games supplied to him over the communications network (5:45-64). See also Figures 1-2 and columns 1-10.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-11, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over James et al. (5,964,660) in view of Merriman et al. (5,948,061) or Hanson et al. (5,947,398).

James et al. teach a system and method for sponsoring games network comprising a communications network (14); a game sponsor gateway in communication with communications network (5:12-17); a user terminal (12) in communication with the communications network to access game sponsoring gateway; a game server in communication with game sponsor gateway to supply games over communications network to user terminal; a sponsor content server in communication with game sponsoring gateway to supply advertising over the communications network to user terminal; a user data server 10 (7:1-10); means for supplying games to game sponsor gateway for delivery over the communications network to user terminal; means for

Art Unit: 3713

selecting user specific advertising and inserting advertising into the game supplied to user terminal (10:17-20); accessing game sponsoring gateway through a communications network; accessing a game from a game provider through game sponsoring gateway; selecting advertising for a specific user; and supplying advertising to the user; and user selecting advertising for display in games supplied to him over the communications network (5:45-64). See also Figures 1-2 and columns 1-10. James et al. do not explicitly teach means for profiling data of user accessing games through user terminal, and supplying profiled data to sponsoring gateway to select advertising for display in games provided to a user terminal; means for determining the location of a user accessing games through a user terminal and supplying the location to the game sponsoring gateway for selecting geographic sensitive advertising for display in games provided to a user terminal; determining user specific profiles for selecting the advertising; determining user's geographic location and inserting the advertising into the game for display to user; game gateway selecting the advertising supplied to the user in games supplied over the network based upon a criteria from a historical database.

Merriman et al. or Hanson et al., however, teach means for profiling data of user accessing games through user terminal, and supplying profiled data to sponsoring gateway to select advertising for display in games provided to a user terminal; means for determining the location of a user accessing games through a user terminal and supplying the location to the game sponsoring gateway for selecting geographic sensitive advertising for display in games provided to a user terminal; determining user specific profiles for selecting the advertising; determining user's geographic location and

Art Unit: 3713

inserting the advertising into the game for display to user; game gateway selecting the advertising supplied to the user in games supplied over the network based upon a criteria from a historical database. See Merriman et al.'s Figures 1-3c and columns 2-8; or Hanson et al.'s Figures 1-3, 6-15, and columns 1-10.

Regarding the limitation of a location server communicating with game sponsor gateway, it is very well known in the global communications network for an affiliate website server to know the location of a requesting source (users or net-surfer's location) by the address of its service provider server.

Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine James et al.'s network gaming with method and system for delivering advertisement of Merriman et al. or Hanson et al. to come up with a system and method for sponsoring games network.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3580 for regular communications and 703-308-7768 for After Final communications.

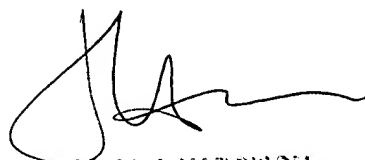
Art Unit: 3713

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Binh-An D Nguyen  
Examiner  
Art Unit 3713



BN  
December 4, 2000



JESSICA J. HARRISON  
PRIMARY EXAMINER